

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Ricky W. Purcell	Examiner:	Isis Ghali
Serial No.:	10/645,447	Group Art Unit:	1615
Filed:	August 20, 2003	Docket:	1443.051US1
Title:	A SYSTEM FOR PROVIDING THERAPY TO A PORTION OF A BODY		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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The applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below:

Claims 40, 41, 43, 46 and 47 were rejected under 35 U.S.C. § 102(b) for anticipation by US 4,592,358. Applicant respectfully submits that '358 does not teach or suggest "a container that includes at least one compartment" in combination with "wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" as recited in claim 40.

Applicant further notes that the therapeutic device 10 disclosed in '358 only describes heating cooling OR heating packets (see '358 at col. 3, line 12, 27, 37). Therefore, Applicant respectfully submits that '358 does not teach or suggest that the cooling OR heating packets are within the therapeutic device 10 at the same time such that disclosed therapeutic device 10 does not hold packets that apply different types of therapy as recited in claim 40. In addition, Applicant respectfully submits that '358 does not teach or suggest "a third patch held by said holder, wherein said third patch applies a third therapy . . . , the third therapy being different than the first and second therapies, wherein the first patch, the second patch, the third patch and the flexible wrap are all within the same compartment in the container" as recited in claim 41.

The Examiner states at page 8 of the Final Office Action that "The container does not impart patentable weight with regard to 102 rejection absent functional relationship between the container and the product, and because the product still function equally effectively with or without the container." Applicant respectfully traverses both parts of the assertion.

Applicant respectfully traverses the first part of the assertion in part because Applicant cannot see why a functional relationship must be imparted between the container and the first and second patches in order to make claim 40 patentable. Applicant notes that claim 40 defines a structural relationship between

the container and the first and second patches by reciting "wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" which is not described in '358.

Applicant respectfully traverses the second part of the assertion in part because applicant does not understand the relevance of the statement. Applicant initially notes that Applicant's system would not function as effectively without a container as a container. As discussed in Applicant's spec. at page 8, lines 6-10, a container is required in order to "reduce the amount of therapy-related items that would otherwise need to be inventoried in order to provide the ability to apply different types of therapy to an injured portion of a body." (See also applicant's spec. at page 2 lines 22-26). Applicant further notes that whether "the product still function equally effectively with or without the container" is not relevant to patentability as '358 must still describe "wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" as recited in claim 40.

The Examiner also states at page 8 of the Final Office Action that "The reference teaches three types of therapy: cooling or heating packets or weights for any particular application. Therefore, these patches are disclosed by the prior art."

Applicant respectfully traverses this assertion. Applicant initially submits that '358 teaches holding cooling packets OR heating packets within the therapeutic device 10 such that '358 does not describe "a first patch held by said container, wherein said first patch applies a first therapy" AND "a second patch held by said container, wherein said second patch applies a second therapy." Applicant also respectfully submits that '358 teaches that the flexible wrap is the container instead of the flexible wrap being within the container such that '358 does not describe "a flexible wrap held by said container . . . wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" as recited in claim 40.

Applicant further respectfully notes with regard to the assertion made by the Examiner relating to the weight disclosed in '358 that the weight does not provide any type of therapy. Therefore, the weight is not a "a third patch held by said container, wherein said third patch applies a third therapy . . . the third therapy being different than the first and second therapies" as recited in claim 41. Applicant further respectfully submits that (i) the weight is incapable of providing any type of therapy; and (ii) '358 does not include any description as to the weight providing any type of therapy.

In addition, Applicant respectfully notes that '358 describes inserting only one type of packet into separate compartments 12 of therapeutic device 10. Therefore, '358 does not describe placing more than one packet (whether they are the same type or not) into one compartment within a container as recited in claim 40.

The Examiner further states at page 8 of the Final Office Action that “Regarding applicant's argument that different therapies are applied at the same time, such limitation is directed to the intended use that imparts no patentability to claims directed to product.” Applicant respectfully traverses this assertion because the Examiner has misconstrued Applicant's argument.

Applicant submits that claim 40 defines a system where the system includes (i) a first patch that applies a first therapy; (ii) a second patch that applies a second therapy; and (iii) a flexible wrap where the first patch, second patch and flexible wrap are all within the same compartment in the container at the same time and the first therapy is different than the second therapy. Applicant again notes that ‘358 only describes placing one type of packet within the therapeutic device at the same time (i.e., heating OR cooling packets).

The Examiner states at pages 8-9 of the Final Office Action that “In any event, the multiple packs of the prior art can be used to provide different therapies at the same time. For example, cold packs can be used in traumatically injured patient that is suffering from bruise, burn and bone fracture. Cold packs can be applied for these three different injuries to provide different therapies at different sites of the body at the same time.” Applicant respectfully traverses this assertion and submits that in Examiner's scenario, the therapeutic device 10 disclosed in ‘358 would be applying the one type of therapy (i.e., cooling therapy) to three different locations on the body instead of using three different patches that apply three different types of therapy as recited in claim 41.

Claim 42 was rejected under 35 U.S.C. § 103(a) as being unpatentable over US 4,592,358 in view of US 6,245,347. Applicant respectfully traverses the rejection because the combination of ‘358 and ‘347 does not describe each and every element of the claimed invention, and combining ‘358 with ‘347 by altering the ‘358 to include a control apparatus 100 as disclosed in ‘347 would destroy the stated purpose of ‘347.

I. ‘358 and ‘347 do not teach or suggest every element of claim 42

As discussed above, ‘358 does not teach or suggest “a container that includes at least one compartment” in combination with “wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container” as recited in claim 40. Applicant further notes that there does not appear to any disclosure in ‘347 related to a holder or container that secures the disclosed patches.

Therefore, Applicant respectfully submits that combination of ‘358 and ‘347 does not teach or suggest where first and second patches are within the same compartment in a container at the same time and are able to apply different types of therapy as recited in claim 40.

Applicant notes that claim 42 depends from claim 40, and as such incorporates all of the limitations of claim 40. Therefore, Applicant respectfully submits that the combination of '358 and '347 does not teach or suggest a system as recited in claim 42.

II. *Combining '358 and '347 would destroy the stated purpose '347*

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01.

Combining '358 with '347 by altering the '358 to include a control apparatus 100 as disclosed in '347 would destroy the stated purpose of '347 which is the "**administration of drugs.**" (See '347 at column 3, lines 54-56). Applicant notes that placing the apparatus 100 into the compartments 12 of '358 would not allow the apparatus 100 to deliver drugs because the apparatus 100 would not engage the skin (which is required for the apparatus 100 in '347 to function properly).

The Examiner also states at page 12 of the Final Office Action that "In response to applicant's argument that placing the control apparatus 100 into the compartments 12 of '358 would not allow the apparatus 100 to deliver drugs because the apparatus 100 would not engage the skin, it is argued that '347 is relied upon for the sole teaching of analgesic patch and for teaching the combination of endothermic, exothermic and analgesic patch in one device." Applicant respectfully traverses the assertion.

Applicant initially submits that the only description as to placing an endothermic, exothermic and analgesic patch within the same compartment in a container is found Applicant's specification and claims. Applicant further notes that '358 does not include any description as to removing any of heating OR cooling packets in order to provide therapy. The therapeutic device 10 disclosed in '358 is meant to operate by inserting heating OR cooling packets into compartments 12 and then securing the therapeutic device 10. Applicant again notes that placing apparatus 100 of '347 into the therapeutic device 10 of '358 would not allow the apparatus 100 to deliver drugs because the apparatus 100 would not engage the skin to administer drugs which is contrary to the specific purpose of '347.

Since combining '358 with '347 would destroy the stated purpose of '347, the rejection should be withdrawn. Reconsideration and allowance of claim 42 are respectfully requested.

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CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at (262) 646-7009 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
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Date _____

By / Andrew Peret /
Andrew R Peret
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11 day of October 2007.

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